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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,807

Applicant(s)

ECKEL, JOHN R.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other:

DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on July 16, 2002 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/405807 is acceptable and a RCE has been established.

Response to Amendment

2. Amendment B, paper number 7 is acknowledged and entered. Claims 1-2, 8, 10, 12, 14, 18, 20, 21, 25, and 26 have been amended. New claims 37-72 have been added. Currently claims 1-72 are pending for examination. A First action on the RCE and with reference to the amendment D follows.

Response to Arguments

3. Applicant's arguments with respect to claims 1-72, filed on 07/16/2002 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 4, 12, 28, 34, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps/structural cooperative relationships of elements, such omission amounting to a gap between the steps/necessary structural connections. See MPEP § 2172.01. The omitted steps/structural cooperative relationships are: said request having a domain name associated with a plurality of domain names each of which includes a common domain name element, said domain name identifying goods/services without identifying a specific provider thereof, said common domain element. In absence of these steps/structural cooperative relationships it is unclear as how name linking policy /common domain name element can be used to further limit the independent claims 1, 18, and 25 of which claims 4, 28, 34, and 36 are dependencies. Note: Further art rejection of these claims is kept pending till receipt of clarification/amendment of these claims.

With regards to claim 12, the omitted step is "step of operating as an intermediary between consumer and provider". Claim 1 does not recite any step of operating as an intermediary between consumer and provider. Claim 1 recites the steps of maintaining a database, receiving a request, selecting a provider and forwarding at least one name of a provider. Therefore, in absence of the step of operating as an intermediary between consumer and provider in claim 1 it is unclear as how the step of enabling the consumer to purchase goods/services can be performed.

Claim Rejections - 35 USC § 102

6 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 3, 6-7, 9-11, 18, 19, 21, 24-25, 32-33, 37, 42-45, 50-52 and 69-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Dean et al. (US Patent 6,055,512).

With regards to claim 1 Dean teaches a method comprising the steps of maintaining a database of personal information relating to a consumer, the personal information having been previously provided by the consumer and including consumer-identified preferred providers (at least see, col.6, lines 23-41, "*Referring to FIG.4...stored data in a database 400....stores the user data in database 400...user data specifies personal preferences or other information as described above.....*". Also see col.2, lines 34-36,), receiving a request initiated by the consumer and transmitted over a global communication network to a system (at least see, col.5, lines 2-17, "*..The gateway devices connect to appropriate...public switched telephone network 105, or a cable TV network 106,...or an on-line service.....Compuserve @..wide area network 107....Internet 108...*"), selecting, responsive to the received request, initiated by the consumer and based upon the personal information relating to thereto in the database, at least one name of at least one provider and forwarding the selected at least one name of the at least one provider from said system to said consumer, wherein said consumer is

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subsequently capable of choosing a provider from the selected at least one provider to communicate therewith (at least see, col.6, line 41-col.7, line 43, "... *The user data specifies personal preferences.....The database also stores a set of service data comprising a list of electronic addresses...for retrieval....leisure interests, travel arrangements, local restaurants.....processor operates a set of search and display algorithms...searches user data....personal references...retrieves data items...displays ..on a user interface....*").

With regards to system, method, and apparatus claims 18, 25, 37, and 45 they recite similar limitations as of claim 1 and are therefore analyzed and rejected accordingly.

With regards to claims 3, 6-7, 9-11, 19, 21, 24, 32-33, 42-44, and 50-52, Dean further teaches that the global communication network is Internet (at least see, col.5, lines 13-16, "... *The service terminal device may connect....wide area network 107, or the Internet 108*"), creating a customized presentation for use by said consumer, said customized presentation containing the selected at least one name of the at least one provider (at least see, col.6, line 41-col.7, line 43, "... *The user data specifies personal preferences.....The database also stores a set of service data comprising a list of electronic addresses...for retrieval....leisure interests, travel arrangements, local restaurants.....processor operates a set of search and display algorithms...searches user data....personal references...retrieves data items...displays ..on a user interface....*)and the customized presentation is selected from the group consisting of: web page, Wireless Application protocol, and other data communication formats (at least see col.4, lines 42-67). Dean also discloses that Service terminal 100 acts as the intermediary between said consumer and said chosen provider (at least see col.4, lines 54-67, and FIG.1). Dean also discloses that the personal information of customer includes privacy instructions and the purchases are done in accordance with the privacy instructions and the privacy instructions

include instructions to make information freely available when authorized by said consumer or never available to the chosen provider (at least see col.5, lines 45-col.9, line 31).

With regards to claims 69-72 Dean teaches that consumer requests can be received from either a desktop device or a hand-held device capable of communicating information (at least see, *col.5, lines 2-6, "...a plurality of user interfaces for example telephone handsets 101, and video monitors 102..."*).

Claim Rejections - 35 USC § 103

8 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 4, 20, 28, 34, 36, 53-55, and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean further in view of Traderonline.com (Press release, "Florida Tops Boat Trader ® Online Activity ", PR Newswire, New York; Sep 22, 1998, pages marked 1, 2, copy of listing of various Internet sites of Traderonline.com as published in 1997, pages marked 3,4,5, Press release, " Seattle Tops RV Trader ® Online Activity ", PR Newswire; New York; Sep 25, 1998, pages marked 6, and Press Release, " Auto Trader ® Online Partners with The Nalley Companies Offering Best Used Vehicle Selection in Atlanta ", PR Newswire; New York; Nov 9, 1998, all extracted from Internet on 04/04/2002), hereinafter referred to as Traderonline.

With regards to claims 2, and 20, Dean teaches a method and system as analyzed in claims 1 and 18. Dean does not teach that said request initiated by the consumer includes a domain name associated with a plurality of domain names each of which includes a common domain name element, said domain name identifying goods/services without identifying a specific provider thereof, said common domain name element is in the form INDEEDSUBJECT.XXX, WHERE "SUBJECT" is a consumer-selected subject matter object and "XXX" is a consumer-selected, top-level extension of domain name. However, Traderonline teaches a system and a method comprising a server for receiving a request from a consumer, transmitted over a global communication network, said request including a domain name associated with a plurality of domain names each of which includes a common domain name element, said server further including a name linking module for selecting, responsive to the received request at least one name of at least one provider; and a controller for forwarding the selected at least one name of the at least one provider to said consumer, wherein said consumer chooses a provider from the selected at least one provider to communicate therewith (at least see, *see pages 1,2,3, and 4*). Traderonline discloses that a customer can send a request through Internet with a domain name like autotraderonline.com or Boattraderonline.com where the common domain element is Traderonline, subject is boat or auto and the extended domain name com. The subject, boat or auto identifies the goods/services requested. The domain name does not identify the provider. On Page 1, Traderonline discloses that there are twenty Internet sites covering automotive, aircraft.....motorcycle ... general merchandise categories. On receipt of the customer's request the site searches and provides the name of providers on a web page.

In view of Traderonline, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Dean to incorporate the feature that said request

initiated by the consumer includes a domain name associated with a plurality of domain names each of which includes a common domain name element, said domain name identifying goods/services without identifying a specific provider thereof, said common domain name element is in the form INDEEDSUBJECT.XXX, WHERE "SUBJECT" is a consumer-selected subject matter object and "XXX" is a consumer-selected, top-level extension of domain name. Doing so would make the procedure of accessing a website for desired goods/services for the user/consumer simple and convenient i.e. one place shopping site, as suggested in Traderonline (at least see page 1, "... *Traderonline....has a complete Internet presence with twenty Internet sites covering the automotive, aircraft.....general merchandise categories...All can be accessed through www.traderonline.com....*". Note: Consumer/user can specify Boat Traderonline.com or Big Truck Traderonline.com or Auto Traderonline.com and accordingly he would be guided to any of these providers after accessing www.traderonline.com).

With regards to claims 4, 28, 34, 36, 53-55, and 61-63, their limitations are covered in claims 2 and 20 and are therefore analyzed and rejected similarly.

10. Claims 5, 22-23, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean/Traderonline and further in view of Turner, Rob ("The price is right ", Money; New York; May 1999, extracted from Internet on 04/04/2002).

With regards to claims 5, 22-23, and 26-27 Dean teaches a method and system as disclosed in claims 1, 18 and 25 respectively. Dean fails to teach the step of using the criteria of price comparison and availability about goods and services offered by the provider in selecting the provider. However, in the same field of selling on the Internet, Turner discloses the step of providing comparative pricing and availability about goods and services offered by the provider (at least see, page 1, last paragraph "...*Fortunately, you can make the Internet do the work for*

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you.....*many new price comparison Websites.....*"). In view of Turner, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Dean to combine the features of Turner i.e. using the criteria of price comparison and availability about goods and services offered by the provider in selecting the provider. Doing so would help customers to find great deals and bargains on the Internet as suggested by Turner (at least see, page 1, "*unearth bargains.....With Thousands of Websites.....there are more ways than ever to find great deals.....*") and save money.

11 Claims 8,12, 14-16, 30-31, 35, 38-40, and 46-48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean and further in view of Daly et al. (US Patent 5,878,141), hereinafter, referred to as Daly.

With regards to claims 8,12,15, and 35, Dean teaches a method as disclosed in claim1. Dean further discloses storing consumer provided personal information relating to personal preferences and privacy instructions and using these personal information of the consumer to select at least one or more provider (at least see, col.5, line 46-col.8, line 31). Dean does not disclose storing payment instructions using a card number or predetermined payment arrangement, making payment as per instructions such that to complete the transactions using a payment method of the system/card number of the system and re-bill said consumer, tracking and awarding rewards.

However, Daly, in the field of electronic commerce and payments, discloses storing payment instructions using a card number or predetermined payment arrangement, making payment as per instructions such that to complete the transactions using a payment method of the system/card number of the system and re-bill said consumer, tracking and awarding rewards (at least see, abstract, "*The purchaser database stores information...purchaser...a set*

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of personal payment methods.....goods/services...”, col.3, lines 1-5, “...for obvious reasons, it is in the purchaser’s interest not to reveal his/her bank account or credit card information to the merchant.....”, col.4, lines 19-29, “...The processor then computes an intersection...the processor consummates the sale and signs....completed transaction has occurred....”, col.5, line 61-col.6, line 24, “..The purchase database stores a set of personal payment methods....credit cards....”, col.7, lines 41-47, “... The software-controlled processor is a trusted third-party...acts as an electronic mediator...without revealing confidential account information to either one...”, col.8, lines 13-20, “..The trusted processing unit and payment method...without revealing the purchaser’s wallet to the merchant.....agreed by the purchaser..”, col.8, lines 47-61, “..If the purchaser...this digital signature assures the merchant...” col.10, lines 33-49,’ .FIG.4 shows a more detailed ..financial transaction system....establish pricing and discounting information...pricing system might also use information in the subscriber database for features such as coupons or frequent buyer programs...”, col.11, lines 7-22, and col.13, line 66-col. 14, line 9, “... The transaction routing system selects a subscriber...Appropriate credit and debit entries are made in general ledger...These are example system 88 and....submitting a bill to the subscriber and posting the appropriate transaction in the acquiring account (such as a credit card account)....account “. Note: tracking the coupons and frequent buyer programs in the database corresponds to tracking the reward programs.).

In view of Daly, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine its features of storing payment instructions using a card number or predetermined payment arrangement, making payment as per instructions such that to complete the transactions using a payment method of the system/card number of the system and re-bill said consumer, tracking and awarding rewards in Dean. Doing so would help the system in customizing and protecting the information displayed by a consumer to the

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intermediary to complete electronic transactions, as suggested by Daly (at least see, col.3, lines 49-53) and also to take advantage of reward system, if any, as further suggested by Daly (at least see, col.10, lines 33-49).

12. Claims 56-57, 59-60, 64-65, and 67-68, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean/Traderonline and further in view of Daly et al. (US Patent 5,878,141), hereinafter, referred to as Daly.

The limitations of claims 56-57, 59-60, 64-65, and 67-68 correspond to the limitations recited in claims 8, 12, 14-16, 30-31, 35, 38-40, and 46-48 and are therefore analyzed and rejected similarly.

13. Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean/Daly and further in view of Matsuoka (US Patent 6,038,537).

With reference to claims 13 and 29, Dean/Daly teaches a method wherein consumer provides personal information relating to consumer including personal preferences, payment instructions and privacy instructions, as disclosed and analyzed in claim 8, above. Dean/Daly does not disclose that the instructions also include instructions to complete transactions in an anonymous manner. However, Matsuoka teaches completing transactions in an anonymous manner (at least see, col.6, lines 38-43, "*....The displaying unit 24 displays a list of commodities to be provided while making the name of a commodity provider anonymous....*", col.10, line 47- col.11, line 14, col.15, lines 26-31, col.29, line 42-col.30, line 32, and col.31, lines 16-18). In view of Matsuoka, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine its features completing the transactions in anonymous manner in Dean/Daly. Doing so would help to keep the privacy of the consumer intact and protecting

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him from unwanted mail and offers from merchants, as per the knowledge generally available and also will help to stop human relationships suffering if transactions are not completed, as suggested in Matsuoka (at least see, col.10, lines 47-55).

14. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dean and further in view of Bi et al. (US Patent 6,311,178), hereinafter, referred to as Bi.

With regards to claim 17, Dean teaches a method as disclosed in claim1. Dean does not disclose further the steps of tracking and ranking a satisfaction level of said consumer. However, in the same field of electronic commerce, Bi teaches tracking and ranking a satisfaction level of said consumer (at least see, abstract, "*...Advantageously, said requirement ...has a search score indicating satisfaction level of said user....ranking of said matching results....*", col.2, lines 12-55). In view of Bi, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine its features of tracking and ranking a satisfaction level of said consumer in Dean. Doing so would help the consumers to be able to not only see offers which match their requirements but ones which satisfy them more than they needed and store these merchants names in their personal preference database for future use.

15. Claims 41 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean and further in view of Matsuoka.

The limitations of claims 41 and 49 correspond to the limitations recited in claims 13 and 29 that is of maintaining the anonymity of the consumer and are therefore analyzed and rejected similarly.

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16. Claims 58 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean/Traderonline and further in view of Matsuoka.

The limitations of claims 58 and 66 correspond to the limitations recited in claims 13 and 29 that is of maintaining the anonymity of the consumer and are therefore analyzed and rejected similarly.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
October 17, 2002


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